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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,679	02/11/2004	Emilio Iacobucci	0001584USU/3061	3825

7590 02/24/2005

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EXAMINER
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NGUYEN, JIMMY T

ART UNIT	PAPER NUMBER
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3725

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/776,679

Applicant(s)

IACOBUCCI, EMILIO

Examiner

Jimmy T Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 5/27/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

This application contains claims directed to the following patentably distinct species of the claimed invention:

Group I. The species of figures 1-6.

Group II. The species of figures 7-8.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-4 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the

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examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

During a telephone conversation with Attorney Paul Greeley on February 18, 2005 a provisional election was made without traverse to prosecute the invention of Group 1, claims 1-11. Affirmation of this election must be made by applicant in replying to this Office action. Claim 12 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention. An action on the merits of claims 1-11 follows.

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, “**two telescopic ball bearing screws** (emphasis added)” (claim 3, lines 2-3); the “**horizontal hinge**” (claim 9, line 4) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an

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application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Information Disclosure Statement***

The information disclosure statement filed on May 24, 2004 has been acknowledged and considered. However, it is noted that the subject matter of the patent listed in the statement has nothing to do with the subject matter of the instant invention.

### ***Specification***

The disclosure is objected to because of the following informalities:

Regarding page 1, lines 28-32, US 5,623,412 does not disclose the compactor as described in lines 28-32. US patent 5,623,412 discloses a processing system for internal combustion engine control, which is not related to the compactor.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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Claim 9 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not provide support for the limitation “a side wall of the moving part that rotates around a horizontal hinge” (emphasis added).

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, line 4, it is unclear whether the limitation “a horizontal plate” is the same horizontal plate as claimed in line 2. Clarification is required.

Regarding claim 4, line 4, it is unclear whether the limitation “a horizontal plate” is the same horizontal plate as claimed in line 2. Clarification is required.

Regarding claim 5, line 3, there is insufficient antecedent basis for the limitation “the waste containers” in the claim.

Regarding claim 6, line 3, there is insufficient antecedent basis for the limitation “the moving parts” (emphasis added) in the claim. Additionally, it is unclear what structural interrelationship exists between the moving parts and other elements (i.e. a compactor, a fixed part, an outer casing,...) as claimed in the preceding claims.

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Regarding claim 7, line 2, it is unclear whether the limitation “the moving part” as claimed is the same moving part as claimed in claim 5, line 2. If they are the same “moving part”, the specification does not provide support for a moving part which house the containers (as claimed in claim 5) having two doors (as recited in claim 7). Further, it is unclear how one moving part comprises two doors.

Regarding claim 9, line 3, it is unclear whether the limitation “the moving part” as claimed is the same moving part as claimed in claim 5, line 2. If they are the same “moving part”, the specification does not provide support for a moving part which house the containers (as claimed in claim 5) can be rotated around a horizontal hinge (as recited in claim 9).

Regarding claim 11, line 2, there is insufficient antecedent basis for the limitation “the moving part” in the claim. Additionally, it is unclear what structural interrelationship exists between the moving part and other elements (i.e. a chamber, a compactor,..) as claimed in the preceding claims.

All claims should be carefully reviewed for clarity and definiteness.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-3, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Hunnicutt (US 3,352,230) in view of Spencer (US 4,870,898).**

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Hunnicuttt discloses a compactor comprising: a metal horizontal plate (40) driven by an electric motor (26), which generates rotary motion, and mechanisms (34), which convert rotary motion into translational motion, for moving said horizontal plate (40), the mechanism is driven by electric motor reducer (28). Hunnicutt discloses the mechanism comprises at least two drive screws (34). Hunnicutt does not disclose the drive screws are the type telescopic ball bearing drive screw. However, the patent to Spencer, teaches that it is old and well known in the compacting art to provide a compactor (fig. 1) with telescopic ball bearing drive screw (fig. 4) for moving a horizontal plate (24) to compact material. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute Hunnicutt's drive screws with the type of telescopic ball bearing drive screw, as taught by Spencer, in order to achieve an effective and simple drive mechanism (col. 1, lines 27-30).

**Claims 4-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Durbin et al. (hereinafter "Durbin") (US 4,719,852) in view of Hunnicutt (US 3,352,230) and Spencer (US 4,870,898).**

Regarding claim 4, as best understood, Durbin discloses a trolley (fig. 1) comprising a waste compactor (fig. 3) wherein the waste compactor comprises: a metal horizontal plate (23) for compacting waste material. Durbin discloses that the horizontal plate is driven by a hydraulic mechanism (col. 5, line 58). Durbin does not disclose the drive mechanism is screw driven mechanism as claimed. However, the patent to Hunnicutt, teaches that it is old and well known in the compacting art, to provide a compactor with a electric motor driven screws mechanism (26, 34) to drive a horizontal compaction plate (40). Therefore, it would have been obvious to



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one having ordinary skill in the art at the time the invention was made to substitute Durbin's hydraulic driven mechanism, with a screw driven mechanism, as taught by Hunnicutt, as such would be a mere substitution of mechanical expedients, in order to drive the horizontal compaction plate.

As to the screw driven mechanism is having the type of telescopic screws. Durbin, as modified by Hunnicutt, does not disclose the drive screws (34) are telescopic screws. However, the patent to Spencer, teaches that it is old and well known in the compacting art to provide a compactor (fig. 1) with telescopic ball bearing drive screw (fig. 4) for moving a horizontal plate (24) to compact material. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute Durbin's drive screws with the type of telescopic ball bearing drive screw, as taught by Spencer, in order to achieve an effective and simple drive mechanism (col. 1, lines 27-30).

Regarding claim 5, as best understood, Durbin discloses the trolley comprises a moving part (25) designed to house waste containers (fig. 8), a fixed part to which the waste compactor is attached (fig. 3), and an outer casing (11); wherein the fixed part and the outer casing also form a single unit (fig. 3).

Regarding claim 6, as best understood, Durbin discloses an electronic means (14) for controlling the operating phases of the waste compactor and of the moving plate (23).

Regarding claim 7, as best understood, Durbin discloses two doors (12, 13).

Regarding claim 8, Durbin discloses a means for facilitating the movement and removal of the waste containers (fig. 9) deformed by the compaction.

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Regarding claim 9, as best understood, Durbin discloses said means for facilitating the movement and removal of the deformed waste containers comprise a wall (64) that rotates about a hinge (fig. 9).

Regarding claim 10, Durbin discloses a chamber for housing two waste containers (fig. 8).

Regarding claim 11, as best understood, Durbin discloses a moving part comprises a central openable partition (25).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art listed on the attached PTO 892 are cited to show various compactors.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jimmy T Nguyen whose telephone number is (571) 272-4520.

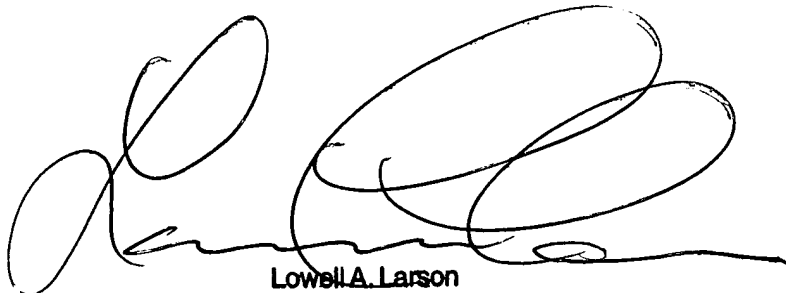
The examiner can normally be reached on Mon-Thur 8:00am - 6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (571) 272- 4419. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JTNguyen  
February 18, 2005



Lowell A. Larson  
Primary Examiner